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Brief  
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10-15-03*

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

Yu Sung (Eduardo) YEH, et al.

EXAMINER: ALVAREZ, R.

SERIAL NO. 09/207,954

FILED: December 9, 1998

GROUP ART UNIT: 3622

FOR: INTEGRATED, INTERACTIVE TELEPHONE AND COMPUTER NETWORK  
COMMUNICATIONS SYSTEM

APPEAL BRIEF

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

This is an appeal from the decision of the Examiner dated March 7, 2003, which  
finally rejected Claims 35-37 and 45-46 in the above-identified patent application.

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I. REAL PARTY-IN-INTEREST

Net2Phone, Inc.

II. RELATED APPEALS AND INTERFERENCES

None.

III. STATUS OF CLAIMS

Claims 35-37, 45 and 46 are currently pending, and Claims 35-37, 45 and 46 are being  
appealed.

#### IV. STATUS OF AMENDMENTS

All amendments in this application have been entered.

#### V. SUMMARY OF THE INVENTION

The present invention is directed to methods for a communications server to deliver a marketing message to two parties (e.g., a caller and a third party) as a conference call is established.<sup>1</sup> With respect to claim 35, the caller is not specified as being associated with a calling card of the system. With respect to claim 36, the caller is specified as being associated with a calling card of the system. In either claimed case, the system retrieves a telephone number of the third party with whom the conference call is to be established.<sup>2</sup> The server can then establish a conference call between the caller and the third party.<sup>3</sup> Lastly, the server delivers the marketing message to the caller and the third party.<sup>4</sup>

#### VI. ISSUES

There are three issues on appeal. The first issue on appeal is the fact-based question of whether the Office Action has overstated the teachings of Riddle, U.S. Patent No. 5,857,189 (hereinafter “the ‘189 patent”), which was cited as part of the Official Notice in the outstanding Office Action. The second and third issues on appeal are the legal questions of whether (1) a first group of claims (i.e., claims 35 and 45) are rendered obvious under 35 U.S.C. 103(a) and (2) a second group of claims (i.e., claims 36, 37 and 46) are rendered obvious under 35 U.S.C. 103(a). Both groups of claims are rejected over an article entitled

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<sup>1</sup> Page 29, lines 8-13.

<sup>2</sup> Page 30, lines 1-5.

<sup>3</sup> Page 30, lines 6-10.

<sup>4</sup> Page 30, lines 11-16.

“Competition drives operators toward retail innovation,” by Mendler (hereinafter “Mendler”), in light of the Official Notice based on the ‘189 patent.

## VII. GROUPING OF THE CLAIMS

All the claims do not stand or fall together. Instead, the claims fall into two different groups. The first group includes claims 35 and 45, and the second group includes claims 36, 37 and 46. The first group of claims is directed to a method for a communication server to deliver a marketing message where the caller is not specified as being associated with a calling card of the system.

With respect to the second group of claims (i.e., claim 36 and its dependent claims), the caller is specified as being associated with a calling card of the system. The two groups of claims are separately patentable since the addition of the calling card in the second group of claims enables the system to be capable of tracking demographics related to the caller. Such demographics may enable the messages that are played to be directed to a particular characteristic of the caller, independent of the number of the third party being called.

## VIII. ARGUMENTS

### A. Introduction

Claims 35 and 36 are both directed to methods of delivering a marketing message to a caller and a third party. With respect to both of these claims, the Office Action is relying on the ‘189 patent to support its Official Notice that “delivering a marketing message to ... 2 parties during a conference call is well known.”<sup>5</sup> However, as discussed in additional detail below, this additional reference does not actually teach marketing messages at all, as alleged.

Moreover, additional limitations recited in the claims are also not found in the cited references.

**B. The '189 Patent Does not Support the Fact Alleged in the Official Notice**

The Office Action has taken “Official Notice that delivering a marketing message to a 2 parties [sic] during a conference call is well known.” In order to support this assertion, the Office Action has cited the teachings of the '189 patent. Specifically, the Office Action alleges that the '189 patent “teaches a system and method which enables teleconference members to share files during a conference call (Abstract). A file sharing accessory allows advertisements (205) to be viewed by the 2 parties.”<sup>6</sup> Based on that citation to the Abstract, the Office Action then concludes that “given the Reese reference [sic; the '189 patent to Riddle] it would have been obvious to a person of ordinary skill in the art ... to have included the teachings of Reese [sic] of delivering a marketing message during a teleconference call to the 2 parties.”<sup>7</sup>

Missing from the Official Notice, however, is the connection between the “advertisement” of the '189 patent and the marketing message of the claims. The “advertisement” of the '189 patent is not a marketing message at all. Rather, it is a notice that a particular file is available for download during a computer-based teleconference. This distinction is most easily seen in col. 14, lines 12-13 in which the '189 patent states “FIG. 12 shows a flowchart of the file sharing accessories initialization as it attempts to copy an advertised file.” Similarly, col. 13, lines 25-29, states “Because it is possible for different members to post advertisements for files having the same name (though a single member can

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<sup>5</sup> Page 4, lines 1-2 of section 4.

<sup>6</sup> Office Action, page 4, section 4, lines 3-5.

not post two files of the same name) it is necessary to check both the file name and which member is attempting to post the advertisement.” These citations confirm that the “advertisement” of the ’189 patent is not a marketing message at all, but rather a notice that is similar to a directory listing of shared files. Accordingly, it is requested that the Board find that the Office Action is factually incorrect and that Riddle in fact does not teach delivering a marketing message during a teleconference.

C. Claims 35 and 45

In addition to Claims 35 and 45 being patentable based on the Office Action’s improper Official Notice, those claims are also patentable based on the absence of other limitations in the cited reference. Claim 35 recites several actions that are performed by or at a server. Specifically, claim 35 recites:

- receiving a telephone call from a caller at said server;
- querying said caller by said server for a third-party telephone number;
- receiving said third-party telephone number at said server;
- establishing, by said server, a telephone conference call between said caller and a third-party at said third-party telephone number; and
- delivering from said server to said caller and said third-party a marketing message during said telephone conference call.

The Office Action has not alleged that a server even exists in the cited MCI reference, let alone that the server performs the recited tasks. The cited functions are all performed by

people in the Mendler article. As such, the literal limitations of the claims are not met. Moreover, if the Office Action is asserting that the MCI operators would be replaced by a server, then the Office Action has identified no teaching that a server calling a potential customer with another existing customer already on the line would in any way increase the likelihood that the potential customer would, in fact, become a customer. The Office Action has seemingly implied that saying no to the operator while a friend or a family member is on the line might be difficult, but there is no evidence of any “peer pressure” when the potential customer is simply saying “no” to a machine instead of a person.

As a result, the Office Action has failed to show (1) that the MCI reference teaches or suggests using a server for any of the claimed functions, (2) that one of ordinary skill in the art would have been motivated to modify the MCI reference to replace human operators with servers, and (3) that it was known to deliver marketing messages by servers during a teleconference. Based on all three of these points, the Office Action cannot support its rejection of claim 35 and 45.

#### D. Claims 36, 37 and 46

In addition the reasons set forth above for the patentability of claims 35 and 45, it is also respectfully submitted that the Office Action has not identified any teaching in the art at the time of Applicants’ invention to show that a calling card number would be useful in the context of delivering, by a server, a marketing message during a teleconference. The Office Action has again taken Official Notice of the fact that prepaid calling cards are known and cited as a motivation that “the caller [would be enabled] to prepay for the call ahead of time.” However, while not excluding it either, the claims do not require prepaying for anything.

Thus, it is respectfully submitted that the Office Action has impermissibly used the Applicants' specification and what is disclosed as a template for creating its rejection.

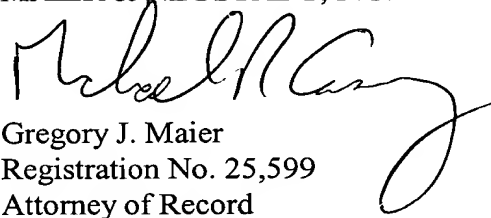
Even if prepaid calling cards are known, the Office Action has not shown that, in the context of server-based marketing messages one of ordinary skill in the art would have looked to prepaid cards to solve or even address any issue that might be unmet by the existing prepaid calling cards.

Conclusion

It is respectfully requested that the outstanding rejection be REVERSED.

Respectfully submitted,

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APPENDIX: APPEALED CLAIMS 35-37, 45 AND 46

35. A method for a communications server to deliver a marketing message, said method comprising the steps of:

receiving a telephone call from a caller at said server;

querying said caller by said server for a third-party telephone number;

receiving said third-party telephone number at said server;

establishing, by said server, a telephone conference call between said caller and a third-party at said third-party telephone number;

delivering from said server to said caller and said third-party a marketing message during said telephone conference call.

36. A method for a communications server to deliver a marketing message, said method comprising the steps of:

receiving a telephone call at said server, from a caller having a calling card, said calling card having a predetermined number of minute credits associated with it;

receiving a calling card number of the caller at the server;

querying, by said server, said caller for a third-party telephone number;

receiving at said server said third-party telephone number;

establishing, by said server, a telephone call between said caller and a third-party at said third-party telephone number;

delivering to said caller and said third-party a marketing message during said initiated telephone call.

37. The method according to claim 36, wherein said server adds an additional number of minute credits to said calling card when said marketing message is delivered.



45. The method as claimed in claim 35, further comprising receiving at the server a number identifying the caller, wherein the marketing message is selected based on demographic information corresponding to the caller as identified by the received number identifying the caller.

46. The method as claimed in claim 36, wherein the marketing message is selected based on demographic information corresponding to the caller as identified by the calling card number.